

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Story et al.
Title: LICENSE MANAGEMENT FOR DIGITAL CONTENT
Application No.: 09/222,336
Filed: December 28, 1998
Group Art Unit: 3622
Confirmation No.: 3308
Examiner: Yehdega Retta

ORAL ARGUMENT REQUESTED

REPLY BRIEF

Dear Sir:

Applicants (hereafter "appellant") hereby submit this Reply Brief in support of its appeal in accordance with the decision of the Pre-Appeal Review Panel. This Reply Brief is filed in response to the Examiner's Answer of November 7, 2008. Appellant respectfully requests consideration of this Reply Brief by the Board of Patent Appeals and Interferences for allowance of the present patent application.

TABLE OF CONTENTS

I.	STATUS OF THE CLAIMS	2
II.	GROUND OF REJECTION TO BE REVIEWED	3
III.	ARGUMENTS	
	A. THE REJECTION OF CLAIMS 1-8, 10-18 and 20-36 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, SHOULD BE REVERSED BECAUSE THE SPECIFICATION CLEARLY DESCRIBES A LICENSE COMPRISING A CARDINALITY	4
	B. REJECTION OF CLAIMS 1-8, 10-18 and 20-36 UNDER 35 U.S.C. § 102(e) AS BEING ANTICIPATED BY U.S. PATENT NO. 5,926,624 ISSUED TO KATZ, ET AL. (KATZ) IS IMPROPER BECAUSE KATZ IS NOT OFFERED TO SHOW A LICENSE COMPRISING A CARDINALITY	16
IV.	CONCLUSION	19

I. STATUS OF THE CLAIMS

Claims 1-8, 10-18 and 20-36 are pending in the present application. Claims 9 and 19 were canceled during prosecution. Claims 31-36 were added during prosecution. Claims 1-8, 10-18 and 20-36 were rejected in the Office Action mailed August 11, 2005 and are the subject of this appeal brief. Claims 34-36 are canceled herein to put the case in a better condition for appeal.

Claims 1-8, 10-18 and 20-36 stand rejected as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1-8, 10-18 and 20-36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,926,624 issued to Katz, et al. (hereinafter "Katz").

ORAL ARGUMENT REQUESTED

Pursuant to 37 C.F.R. § 41.47, appellant hereby requests oral argument. A separate paper requesting oral argument (PTO/SB/32) in compliance with 37 C.F.R. § 41.47(b) is transmitted herewith.

II. GROUND OF REJECTION TO BE REVIEWED

1. Whether the subject matter of claims 1-8, 10-18 and 20-36 is described in appellant's specification such that it reasonably conveys to one of ordinary skill in the art that the inventors had possession of the claimed invention at the time the application was filed.

2. Whether claims 1-8, 10-18 and 20-36 are anticipated by Katz.

III. ARGUMENT

**A. THE REJECTION OF CLAIMS 1-8, 10-18 and 20-36
UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, SHOULD BE
REVERSED BECAUSE THE SPECIFICATION CLEARLY
DESCRIBES A LICENSE COMPRISING A CARDINALITY**

Claims 1-8, 10-18 and 20-36 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter that was not described in the specification in such a way as to convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

Central to this appeal is the issue of whether appellant's specification supports the claim feature of a "license comprising a cardinality." Appellant respectfully submits that a plain and straightforward reading of the specification shows that this feature is indeed fully supported by an enabling written description and does not constitute new matter.

In short, appellant's specification teaches the following: 1) a user may request a license that allows the playback of digital content on his or her playback device; 2) the user may specify the cardinality of the license when making the license request; 3) a license management device creates a license having the specified cardinality; 4) the

license is transmitted to the user for installation on certain of the user's playback device(s); and 5) the number of playback devices which can store the license is restricted by the cardinality component of the license.

Support for these features can be found in numerous places in specification, including at page 11, line 10 to page 15, line 8 and in FIGS. 5 and 6. Nevertheless, in an attempt to focus on the specific issue at hand, appellant points to three specific sections of the specification. Namely, page 11, lines 10-11, page 14, lines 6-8 and page 14, lines 11-13, respectively, which explain that:

In operation, license management device 510 creates a license having a cardinality in response to a request.

A license is requested at 610. In one embodiment, a user of a playback device accesses a license management device and requests a license having a specific cardinality.

The license management device creates a license at 620. The license has a cardinality that determines the number of playback devices in which the license can be stored.

From these and the other sections cited above, appellant's specification clearly explains that the license itself contains a cardinality component. The subject of

each of these excerpts is the license, which is described as being created by the license management device and is modified to include the cardinality component requested by the user. Consequently, a plain and straightforward reading of the specification shows that ample written description exists in multiple places for the "license comprising a cardinality" feature and thus does not constitute new matter.

Further support for appellant's position may be found at pages 13, lines 3-8 and 15-16, respectively, which explain that:

In the following example, it is assumed that a household of four individuals (Husband, Wife, Son and Daughter) has four playback devices; one for each individual. Each member of the household may wish to have access to the "New York Times." The household obtains a license with a cardinality of four to store in each of the playback devices. The playback devices are then authorized to play digital versions of the "New York Times" that include the license that is also stored in the playback devices. (emphasis added)

Husband and Son may wish to have access to "Sports Illustrated." The household obtains a license with a cardinality of two.

Similar to the three sections of specification cited above, each of these other sections also clearly explain

that a user, in this case the household, obtains a license with a specified cardinality. Again, it is the license itself which is requested and created with the requisite cardinality, and subsequently delivered to the user.

Moreover, support for this feature may be found in the claims as originally filed, in which substantially word for word support may be found, further constituting adequate written description. See MPEP 608.01 (1); *In re Gardner*, 480 F.2nd 879, 880, 178 USPQ 149 (CCPA 1973); *PTO Written Description Guidelines* stating that a strong presumption of an adequate written description exists for an original claim; *Lampi Corp. v. American Power Products, Inc.* 228 F.3d 1208, 56 USPQ2d 1445 (Fed Cir. 2000).

Accordingly, appellant's specification provides clear and ample written description for the "license comprising a cardinality" feature at issue in this appeal. No new matter has been added.

Reply To Examiner's Response

A primary issue of this appeal is concerned with the role and function of the disclosed license, and more specifically, the role and function of the 32 bit group identifier relied on in sustaining the present rejection. In particular, it appears the present rejection is based on

the belief that the cardinality of license disclosed in appellant's specification must be limited to a certain specific data structure described in the specification which is used in some embodiments to identify groups of users (*i.e.*, a 32 bit group identifier), and that the number of devices identified by 32 bit group identifier is necessarily equal to the cardinality. For example, page 7 of the Answer states that:

Contrary to Appellant's argument, the cardinality (number of devices that can play the content) is controlled by authorizing playback devices that include this "bit identifier" (license) to play the content. Therefore, as disclosed by Appellant, the devices that include the license (32 bit group identifier) indicate the number of cardinality [sic] for that content. If one device includes such identifier, than [sic] the cardinality is one if three devices include the identifier, the cardinality is three. In short the number or the cardinality is determined by the number of playback devices that are authorized to play the content *i.e.* which have the "bit identifier."

If the license (32 bit Group ID) has a cardinality component, as indicated by Appellant, however it is not taught or discloses [sic] where in that identifier is the cardinality component. In short for the license to consist of cardinality, the specification does not teach which part of the 32 bit Group ID or how the 32 bit Group ID provides indication of how many devices are authorized.

Appellant respectfully submits that the above explanation mischaracterizes the operation of the disclosed invention in at least several ways, including: 1) the 32

bit group identifier relates to the cardinality, 2) the disclosed license is somehow limited to only the 32 bit group identifier data structure; and 3) the number of devices identified by the 32 bit group identifier must necessarily be equal to the cardinality.

The following discussion points to certain applicable sections of the specification which disclose and explain the operation of the claimed invention, and illustrate why these positions are inaccurate.

Initially, it is constructive to consider the portion of appellant's specification that is concerned with the request and delivery of the license to set the proper background. Page 11, lines 10-18 explains that:

In operation, license management device 510 creates a license having a cardinality in response to a request. In one embodiment, authentication (e.g., login name and password) is required from a license requestor to authorize license creation. For example, an owner of a playback device can request a license to authorize a playback device he or she owns for playback of specified digital content by logging in to a specific Web page associated with license management device 510. In one embodiment, the cardinality of the license determines the number of playback devices that the license authorizes to play digital content. The license created by license management device 510 is stored in one or more playback devices (e.g., 550 and/or 560).

Thus, as described in the specification, a user, (which may include multiple devices and other users) such

as a household, requests a license with a certain cardinality. In order to obtain the requested license, the user identifies himself to the license management device 510 (e.g., through a login name and password) and authorizes the creation of the license with a specified cardinality, which is then supplied or targeted to playback devices of that user.

Next, the targeted license is stored in one or more playback device of the user (e.g., see page 12, lines 9-11). As explained in appellant's specification, in one embodiment, the requested license may include a group identifier (e.g., a 32 bit group identifier) that identifies the user (and the user's devices) requesting the license to ensure that each playback device storing the license belongs to the user requesting the license (to prevent unauthorized download). This is explained at page 12, lines 16-19, which states that:

In one embodiment, the license comprises a 32 bit group identifier; however, other identifier sizes can also be used. Thus, each playback device storing a license belongs to a set of one or more playback devices storing the license. The set of playback devices is authorized to play digital content that includes the license.
(emphasis added)

The plain language of this specification excerpt illustrates that the 32 bit group identifier merely identifies a group (e.g., a set) of one or more playback devices of a certain user (as the plain meaning of its name implies). The 32 bit group identifier is not concerned with providing cardinality information. No portion of the specification teaches otherwise.

In fact, as explained above, written description exists in several places of the specification describing a license having a cardinality parameter. As shown above, the addition of a 32 bit group identifier is deliberately identified as being in one embodiment and not required in all embodiments. More specifically, written description support also exists for a license further having a group identifier. Thus, appellant's specification describes a license having, in at least one embodiment, both a group identifier and a cardinality parameter. No explanation is provided as to why this interpretation of the written description is inaccurate or otherwise inadequate.

Appellant's position on this point is further supported by an illustrative example found in the specification at page 13, lines 3-20, which explains that:

In the following example, it is assumed that a household of four individuals (Husband, Wife, Son and Daughter) has four playback devices; one for each individual. Each member of the household may wish to have access to the "New York Times." The household obtains a license with a cardinality of four to store in each of the playback devices. The playback devices are then authorized to play digital versions of the "New York Times" that include the license that is also stored in the playback devices.

The members of the household may also wish to have access to "People." The license used for the "New York Times" can also be used for "People." The license management device communicates to the content provider that provides "People" that the previously generated license should be used to authorize playback of "People." The provider of "People" includes the license in a digital version of "People" and the playback devices can play digital versions of "People."

Husband and Son may wish to have access to "Sports Illustrated." The household obtains a license with a cardinality of two. The license is stored in the playback devices used by Husband and Son as well as communicated to the provider of "Sports Illustrated." The provider of "Sports Illustrated" includes the license in a digital version of "Sports Illustrated" and the two playback devices storing the license with cardinality of two are authorized to play "Sports Illustrated."

It is seen from this specification excerpt that a given user (which may include multiple playback devices and other users), such as a household, may have four playback devices (one for each member of the household). In this case, the group "household" may obtain a license that allows each of the four playback devices to play certain content. As described, the license for the "New York Times" includes a group identifier (e.g., a 32 bit group

identifier) that identifies the four playback devices in the group "household" and includes a cardinality component that specifies the number of those playback devices that are authorized to download the license (in this case four).

However, in connection with the "Sports Illustrated" license, the group "household" obtains a license having a cardinality of two. In this instance, despite the fact that the group identifier identifies four playback devices in group "household," the cardinality restriction only allows two of those four playback devices to download the "Sports Illustrated" license. Consequently, in this example, the number of playback devices identified by the group identifier and the number of playback devices authorized by the cardinality parameter are not the same.

Accordingly, this example disproves the assertion in the Answer that the 32 bit group identifier provides cardinality information and that the cardinality must be equal to the number of devices identified by the group identifier. Furthermore, appellant's specification discloses that the cardinality may be modified after the license generated (page 14, lines 14-15). This would not be possible if the playback devices identified by the group identifier and the number of playback devices authorized by

the cardinality parameter are always required to be the same.

As a result, any limitations associated with this position that form the basis of the current rejection are unsupported by appellant's specification and thus should be withdrawn.

Furthermore, appellant respectfully points out that the specification explains that in one embodiment, the license comprises a 32 bit group identifier. It is a well accepted principle of U.S. patent law that the phrase "in one embodiment" and the word "comprises" are to be interpreted as open ended and non-limiting. When this proper meaning is applied to appellant's specification, it is clear the specification teaches that the disclosed license may include, but is not limited to, a 32 bit group identifier.

On the other hand, the position taken in the Answer attempts to impermissibly limit the license to include only the 32 bit group ID: "the specification does not teach which part of the 32 bit Group ID or how the 32 bit Group ID provides indication of how many devices are authorized" (Answer page 7, lines 10-12). Nowhere in the specification does appellant limit the disclosed license to only include

the 32 bit group ID. By choosing the phrase "in one embodiment" and the word "comprising" to modify license in this section of the specification, appellant made a deliberate and conscious decision not to limit the content of the license to only this specific data structure. Accordingly, limiting the disclosed license to include only a 32 bit group ID is improper.

In view of the foregoing discussion, it is clear that, in one embodiment, the license disclosed by appellant's specification includes an authorization component (see, for example, appellant's specification, page 12, lines 3-7) a cardinality component (see, for example, appellant's specification, page 10, lines 10-11, page 14, lines 6-8 and page 14, lines 11-13) and a group identifier component (see, for example, appellant's specification, page 7, lines 16-19).

Moreover, appellant notes that digital licenses and their construction were very well known at the time this application was filed. Also very well known at the filing date of this application was how to digitally represent a number (such as the cardinality parameter discussed herein). Appellant need not provide the specific low level implementation details of such very well known technologies

in its specification to fulfill the written description requirement. See, for example, *Hyatt v. Boone* 47 USPQ2d 1128 (Fed. Cir. 1998) "This court has often observed that minutiae of descriptions or procedures perfectly obvious to one of ordinary skill in the art and yet unfamiliar to the laymen need not be set forth." Also see *LizardTech, Inc. v. Earth Resource Mapping, Inc.* 424 F.3d 1336 (Fed. Cir. 2005), *reh'g en banc denied* 433 F.3d 1373 (Fed. Cir. 2006); and *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995).

Accordingly, appellant respectfully submits the specification provides a clear and ample written description for the claim feature "license comprising a cardinality" at issue in this appeal. No new matter has been added. Thus, the rejection pursuant to 35 U.S.C. § 112, first paragraph, should be withdrawn.

B. REJECTION OF CLAIMS 1-8, 10-18 and 20-36 UNDER 35 U.S.C. § 102(e) AS BEING ANTICIPATED BY U.S. PATENT NO. 5,926,624 ISSUED TO KATZ, ET AL. (KATZ) IS IMPROPER BECAUSE KATZ IS NOT OFFERED TO SHOW A LICENSE COMPRISING A CARDINALITY

Claims 1-8, 10-18 and 20-36 stand rejected under 35 U.S.C. § 102(e), as clearly being anticipated by Katz.

As explained on page 9 of the Answer, this rejection is based on the assumption that: 1) appellant's license

is limited to a 32 bit group ID, and that: 2) the cardinality of the present invention is provided by the 32 bit group ID.

However, appellant has demonstrated above that both of these positions are inaccurate. As a result, the rejection with respect to Katz is moot. In particular, it has been clearly demonstrated above that the license includes both a group identifier and a cardinality parameter. The group identifier does not provide cardinality information. Moreover, the disclosed license is not limited to merely a 32 bit group ID, but rather as having a license component and a cardinality component.

Nonetheless, appellant presents discussion below explaining why the pending claims are allowable over Katz. Katz discloses a digital library and a mobile playback device that can be used to play digital content from the digital library. See, for example, Fig. 2. Katz discloses that playback devices can be members of one or more groups and include a group ID. See Katz, col. 12, lines 39-67. However, the group ID of Katz is merely a number that identifies a group. The group ID does not indicate a number of playback devices in the group nor does it provide any restriction on the content

a particular device may play. Thus, Katz fails to show or suggest a license comprising a cardinality as specified in appellant's pending claims.

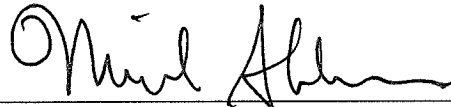
For at least the foregoing reasons, appellant submits that pending claims, including claims 1-8, 10-18 and 20-33 are not anticipated by Katz. Appellant therefore requests that the rejection of these claims under 35 U.S.C. § 103(a) be reversed.

IV. CONCLUSION

Appellant respectfully submits that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

Date: 1/6/09

Respectfully submitted,



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